



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Chan et al.
Serial No.: 09/716,734
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Examiner: A. Williams
Art Unit: 2826
Our File No.: 00100.01.0012
Docket No.: 0100.0100120

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Title: **INTEGRATED CIRCUIT PACKAGE AND METHOD OF FABRICATING
SAME**

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Attn: Examiner A. Williams

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Karenina Oliver
Karenina Oliver

RESPONSE

Dear Sir:

This is in response to a Restriction Election Requirement mailed November 27, 2002. The Examiner noted the shortened statutory period for reply of one month, therefore, Applicants respectfully submit a request for one month extension of time and the associated petition fee of \$110.00. Applicants respectfully traverse the Examiner's restriction election.

ELECTION OF SPECIES

In the event the below position proves unsuccessful in persuading the Examiner that the present restriction election is improper, Applicants specifically elect Species I directed to claims 2-9, 12, 17 and 21-23.

POSITION IN SUPPORT AGAINST RESTRICTION ELECTION

In the present Office Action, Applicants have been issued a third restriction election. On January 29, 2002, Examiner Williams indicated that the invention is restricted to two separate and patentably distinct devices through claims 1-20 and claims 21-27. In response to a submission by Applicants, the Examiner on June 3, 2002 withdrew the previous restriction

election and required the election of one of three patentably distinct species of inventions, more specifically claims 1-6 and 21-27, claim 17, and claims 18-20. Furthermore, in response to Applicants' position, the Examiner on November 27, 2002 issued another restriction election, this time indicating that the application contains claims directed to eight separate and patentably distinct species of the claimed invention, with claim 1 being a generic claim. Applicants respectfully traverse the Examiner's assertion of the existence of eight separate and patentably distinct species under claim 1 as the generic claim.

Restriction elections regarding species and genus are covered in MPEP §806.04, whereas more specifically, MPEP §806.04(f) states "claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not for the first." Furthermore, MPEP §2111.03 indicates that "the transitional term "comprising", which is synonymous with "including," "containing," or characterized by," is inclusive or open ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Genentech, Inc. v. Shiron Corp.*, 112F.3d 495, 501, 402 USPQ2d 1608, 1613 (Fed. Cir.1997)."

Looking specifically at the Examiner-noted second, third and fourth species regarding claims 13 and 15, Applicants respectfully traverse the mutual exclusivity of these events. More specifically, for an event to be mutually exclusive, the occurrence of one event excludes the possibility of the other event. Claim 13 recites "the integrated circuit package of claim 12, wherein both the first substrate and the second substrate comprise silicon." As stated above, the transitional phrase comprising is an open ended statement, therefore it is respectfully submitted through the usage and the application of the term comprising, the claimed limitations of claims 13, 14 and 15 wherein the first substrate and the second substrate comprise silicon, gallium arsenide and silicon germanium, respectively, are not mutually exclusive events. Stated another way, as claims 13-15 recite that the first substrate and the second substrate comprise a specific element, the claimed limitation of comprising this element does not exclude the possibility of other elements. Therefore, by logical definition, these claimed limitations are not mutually exclusive and therefore specific restriction element requirements herein are improper.

Applicants respectfully submit the same logical analysis applies equally and as effectively to the other noted species specifically Species V-VIII, wherein each of these claimed limitations recite the transitional phrase "comprising." Therefore, by logical definition, and accordance with MPEP §2111.03 and MPEP §806.04(f), the claimed limitations are not mutually exclusive and therefore the present restriction election is improper.

As such, Applicants respectfully traverse the Examiner's asserted restriction election and respectfully submit herein that the restriction election is improper and that all claims may be examined in the present application.

Accordingly, Applicant respectfully submits that the claims are in condition for allowance and that a timely Notice of Allowance be issued in this case. The Examiner is invited to contact the below-listed attorney if the Examiner believes that a telephone conference will advance the prosecution of this application.

Date: January 8, 2003

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Respectfully submitted,

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